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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,612	07/25/2003	Shushi Ikeda	240733US0	9365

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EXAMINER

YEE, DEBORAH

ART UNIT PAPER NUMBER

1742

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/626,612

Applicant(s)

IKEDA ET AL.

Examiner

Deborah Yee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) 6-8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2-28-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 3 to 5, 9 and 10 stand rejected under 35 U.S.C. 103(a) as being unpatentable over JP'759 or JP'853 for the reasons set forth in office action dated January 20, 2006.

3. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP'759 or JP'853 as applied to claims 1,3-5 , 9 and 10 above, and further in view of EP'780 for the reasons set forth in office action dated January 20, 2006.

4. Claims 1 to 5,9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP'780 for the reasons set forth in office action dated January 20, 2006

Response to Arguments

5. Applicant's arguments filed April 20, 2006 have been fully considered but they are not persuasive. It was stated that JP'759, JP'853 and EP'780, each do not disclose or suggest the limitation wherein "...there exist no more than 40 carbide grains per 2000 microns in the steel sheet between the retained austenite and ferrite" as recited by claim 1 . It is the examiner's position that prior art teaches a steel sheet having a

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composition and microstructure which closely meets the present invention, and exhibit essentially the same present invention properties of high tensile strength at greater than 600MPa and high elongation at more than 30% and excellent bendability. Since composition, microstructure, and properties are closely met, then the claimed carbide limitation of no more than 40 carbide grains per 2000 microns between the retained austenite and ferrite would be expected in absence of proof to the contrary.

6. It was stated that the cited prior art fails to suggest the precise 2-stage heat treatment of the present invention. It is the examiner's position that since claims are directed to a product-by-process, then patentability is determined by the product per se and not the process limitations. Applicant has the burden to show that prior art products do not necessarily or inherently possess the characteristics of the claimed product.


7. Moreover, EP780 in claim 12 on page 20 teaches processing alloy in substantially the same manner as taught by applicant comprising the steps of hot rolling at austenitic temperature with a finishing temperature of A_r to $100C + 100A_r3$ (overlaps claim A1 to A3 point), cooling to A_r1 to A_r3 (within $700 \pm 30C$) and holding for 1 to 20 seconds (overlaps 10-30seconds), then cooling at $20C/sec$ (within greater than $10C/sec$) to a coiling temperature at 350 to $450C$ (within $400 \pm 50C$) followed by air cooling.

8. Furthermore, the 1.132 Declaration submitted May 25, 2005 is not deemed persuasive because it fails to demonstrate and compare the differences between JP'759, JP'853 and EP'780 with the present invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 571-272-1253. The examiner can normally be reached on Monday-Friday from 6:00 to 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Deborah Yee
Primary Examiner
Art Unit 1742

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